

Serial No.: 09/683,417
Attorney Docket No.: F-428

RECEIVED
CENTRAL FAX CENTER

OCT 16 2007

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In re patent application of:) Attorney Docket No.: F-428
Denis J. Stemmler) Customer No.: 00919
Serial No.: 09/683,417)
Confirmation No. 2989) Examiner: MILLER, WILLIAM L.
Filed: December 24, 2001) Group Art Unit: 3677
)
) Date: October 16, 2007

Title: METHOD AND SYSTEM FOR DECONTAMINATING MAIL

Mail Stop Appeal Brief- Patents
Commissioner for Patents
Alexandria, VA 22313-1450

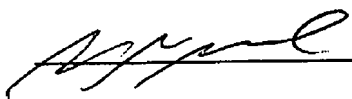
APPELLANT'S BRIEF ON APPEAL

Sir:

This is an appeal pursuant to 35 U.S.C. § 134 and 37 C.F.R. §§ 41.31 et seq. from the final rejection of claims 26-27, 34-35 and 37-42 of the above-identified application mailed March 15, 2007. This Brief is in furtherance of the Notice of Appeal transmitted in this case on July 16, 2007. A petition and fee for a one-month extension of time to respond is transmitted herewith. Accordingly, this brief is timely filed. A \$340.00 Appeal fee was previously submitted on October 13, 2004. The fee for submitting this Brief is \$510.00 (37 C.F.R. § 1.17(c)) less the previously submitted fee. Please charge Deposit Account No. 16-1885 in the amount of \$170.00 to cover the additional fees. The Commissioner is hereby authorized to charge any additional fees that may be required for this appeal or to make this brief timely or credit any overpayment to Deposit Account No. 16-1885.

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, on October 16, 2007 (Date of Transmission).
George M. Macdonald, Reg. No. 39,284 (Name of Registered Rep.)



(Signature)

October 16, 2007 (Date)

10/18/2007 SSITHIB1 00000071 161885 09683417

01 FC:1402 510.00 DA

(0074451.1)

1/17 October 16, 2007 Appellants' Appeal Brief

09683417
10/18/2007 10/18/2007 SSITHIB1
01 FC:1402 340.00 CR

Serial No.: 09/683,417
Attorney Docket No.: F-428

Patent
RECEIVED
CENTRAL FAX CENTER

OCT 16 2007

TABLE OF CONTENTS

- I Real Party in Interest
- II Related Appeals and Interferences
- III Status of Claims
- IV Status of Amendments
- V Summary of Claimed Subject Matter
- VI Grounds of Rejection to Be Reviewed on Appeal
- VII Argument
- VIII Claims Appendix
- IX Evidence Appendix - None.
- X Related Proceedings Appendix – None.

Serial No.: 09/683,417
Attorney Docket No.: F-428

Patent

I. Real Party in Interest

The real party in interest in this appeal is Pitney Bowes Inc., a Delaware corporation, the assignee of this application.

II. Related Appeals and Interferences

There are no appeals or interferences known to Appellant, his legal representative, or the assignee that will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. Status of Claims

Claims 1-25, 28-33 and 36 are canceled without prejudice or disclaimer.

Claims 38, 39 and 42 are in the case and under final rejection of the Examiner and stand rejected under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the written description requirement. Claims 38, 39 and 42 are noted as otherwise allowable over the prior art of record.

Claims 26 and 34 are in the case and under final rejection of the Examiner and stand rejected under 35 U.S.C. § 103(a) as allegedly being rendered obvious by U.S. Patent Application Publication No. 2004/0020978 by Webb ("Webb '978") in view of U.S. Patent No. 4,673,914 to Lee ("Lee '914").

Claims 27, 37 and 40-41 are in the case and under final rejection of the Examiner and stand rejected under 35 U.S.C. § 103(a) as allegedly being rendered obvious by U.S. Patent Application Publication No. 2004/0020978 by Webb ("Webb '978") in view of U.S. Patent No. 4,673,914 to Lee ("Lee '914") and further in view of U.S. Patent No. 6,997,374 to Stradley, et al. ("Stradley '374").

Claim 35 is in the case and under final rejection of the Examiner and stands rejected under 35 U.S.C. § 103(a) as allegedly being rendered obvious by U.S. Patent Application Publication No. 2004/0020978 by Webb ("Webb '978") in view of U.S. Patent No. 4,673,914 to Lee ("Lee '914") and further in view of U.S. Patent No. 6,646,270 to Cunningham ("Cunningham '270").

Appellant hereby appeals the final rejection of claims 26-27, 34-35 and 37-42.

Serial No.: 09/683,417
Attorney Docket No.: F-428

Patent

IV. Status of Amendments

There are no amendments to the claims filed subsequently to the Final Office Action of March 15, 2007. Therefore, the claims set forth in Appendix A to this brief are those as set forth before the final rejection.

V. Summary of Claimed Subject Matter

Appellant's invention as presently claimed relates to methods and systems for decontaminating mail during a relatively long period of time in a mailbox. See Specification at ¶¶ 0001, 0063-0065. Figure 4a is reproduced below.

As described in paragraphs 63-65 of the Specification and as shown in FIG. 4a, a mailbox 410 includes a controller 450. UV C radiation sources at 260 nm 430, 432 are connected to a controller 450. The controller 450 is connected to a decontamination start switch 470, a timer and a display 418. The mailbox 410 is shielded to prevent UV C radiation from escaping and is reflective. The mailbox interior has dividers 440 that allow the UV C energy to bathe the surfaces of each mail piece placed in each of the slots created by dividers 440. Divider bottom 442 is at least partially transparent to UV and allows UV C energy to bathe the bottom surfaces of the mail pieces. The postal worker places the mail in the mailbox, closing the door. The postal worker uses a key to turn the switch 470 to start the decontamination and the postal worker leaves.

Independent claim 26 recites:

26. A mailbox for decontaminating mail comprising:
a door for allowing access to the interior of the mailbox;
a decontamination system operatively connected to a controller for decontaminating mail;
at least one divider for separating mail; and
a keyed start switch that is engaged and switched to start when a physical key is inserted and turned and that is used to send a decontamination start signal to the decontamination system and to restrict decontamination start signal generation to the mail carrier possessing the physical key.

Serial No.: 09/683,417
 Attorney Docket No.: F-428

Patent

Door 411 swings on hinges 414, 416. A decontamination system includes UV radiation sources 430, 432 that are connected to a controller 450. Divider 440 includes a bottom 441. A keyed start switch 470 is utilized.

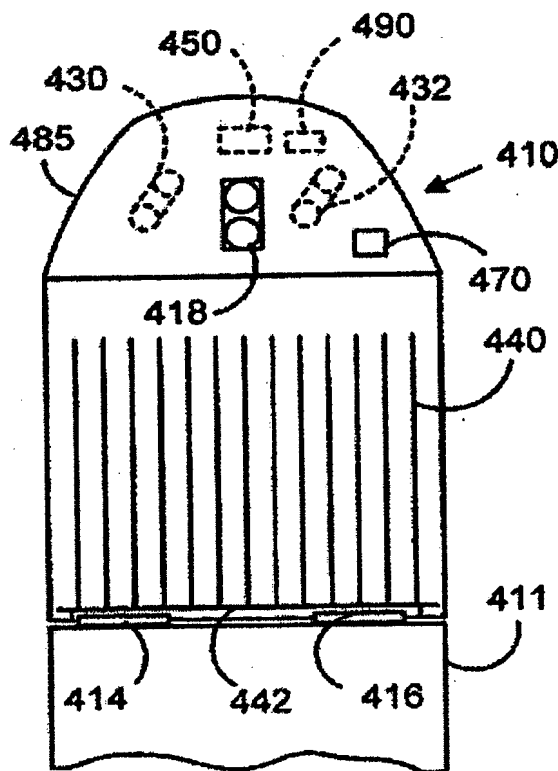


FIG. 4A

Independent claim 34 recites:

34. A decontaminating device including a decontamination chamber comprising:
 a door for allowing access to the interior of the decontamination chamber;
 a decontamination system operatively connected to a controller for decontaminating mail;
 at least one divider for separating mail; and
 a keyed start switch that is engaged and switched to start when a physical key is inserted and turned and that is used to send a decontamination start signal to the decontamination system and to restrict

Serial No.: 09/683,417
Attorney Docket No.: F-428

Patent

decontamination start signal generation to the mail carrier possessing the physical key.

Door 411 swings on hinges 414, 416. A decontamination system includes UV radiation sources 430, 432 that are connected to a controller 450. Divider 440 includes a bottom 441. A keyed start switch 470 is utilized.

Independent claim 42 recites:

42. A mailbox for decontaminating mail comprising:
a door for allowing access to the interior of the mailbox;
a decontamination system including a UV source operatively connected to a controller for decontaminating mail;
reflective shielding operatively connected to the mailbox to prevent UV radiation from escaping;
at least one divider for separating mail including divider material that is at least partially transparent to UV radiation; and
a start switch that is engaged and that is used to send a decontamination start signal to the decontamination system.

Door 411 swings on hinges 414, 416. A decontamination system includes UV radiation sources 430, 432 that are connected to a controller 450. Divider 440 includes a bottom 441. A keyed start switch 470 is utilized. The mailbox 410 is shielded to prevent UV C radiation from escaping and is reflective.

The display 418 displays a warning and the door is locked. The UV C lights are lit for a predetermined time such as three hours and provide at least 20 milliwatts per centimeter squared of 260-nanometer light. One or 5 hours may be utilized, however, other time periods may be effective. After the predetermined time expires, the door is unlocked and the display indicates it is safe to open the door and retrieve the mail.

As described in paragraph 76, the mailbox may utilize a communications channel and communications device to provide an indication inside a home in step 720 that "the mail has arrived" followed in step 750 by an indication that "the mail is being sanitized" and then followed in step 770 by an indication that "it is now safe to pick up and open your mail."

Additional features of the invention are discussed below in the Argument section of this Brief. This summary is not intended to supplant the description of the claimed

Serial No.: 09/683,417
Attorney Docket No.: F-428

Patent

subject matter as provided in the claims as recited in Appendix A, as understood in light of the entire specification.

VI. Grounds of Rejection to Be Reviewed on Appeal

Whether claims 38, 39 and 42 are patentable under 35 U.S.C. §112, first paragraph.

Whether claims 26 and 34 are patentable under 35 U.S.C. §103(a).

Whether claims 27, 37 and 40-41 are patentable under 35 U.S.C. §103(a).

Whether claim 35 is patentable under 35 U.S.C. §103(a).

VII. Argument

As discussed in detail below, Appellant respectfully submits that the final rejection of claims 26-27, 34-35 and 37-42 does not meet the threshold burden of presenting a prima facie case of unpatentability. Accordingly, Appellant is entitled to grant of those claims. In re Oetiker, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

A Claims 38, 39 and 42 are not Unpatentable under 35 U.S.C. § 112

Claims 38, 39 and 42 are in the case and stand rejected under 35 U.S.C. § 112, first paragraph as allegedly failing to satisfy the written description requirement. Appellant notes that the Examiner has stated that these claims are otherwise patentable over the cited art.

Appellants respectfully disagree with the rejection and urge its reversal. The written description is the technologic disclosure of the invention and serves the fundamental purpose of making known what was invented and need not include information already known to the public. *Space Sys./Loral Inc. v. Lockheed Martin Corp.*, 405 F.3d 985 (Fed. Cir. 2005).

Dependent claim 38 recites (with similar limitations in dependent claim 39 and Independent claim 42):

Serial No.: 09/683,417
Attorney Docket No.: F-428

Patent

38. The mailbox of claim 26 wherein:
the divider material is at least partially transparent to UV radiation.

The Examiner claims that the amendment that added the term material introduced new matter and incorrectly states that the Applicant was "silent with respect to the material of the divider." Final Rejection at 2 (emphasis added).

However, Paragraph 63 of the specification states:

Referring to FIG. 4A, another embodiment is described. Ultra violet (UV) light, particularly the light in the UV C spectrum is narrow wavelength light that is effective at killing bacteria on surfaces. Anthrax has been transported on the surface of envelopes. ... The mailbox interior has dividers 440 that allow the UV C energy to bathe the surfaces of each mail piece placed in each of the slots created by dividers 440. Divider bottom 442 is at least partially transparent to UV and allows UV C energy to bathe the bottom surfaces of the mail pieces. ...

The Examiner further speculates that the Divider could have been perforated to allegedly bathe the bottom of the mailpieces in UV (although the Examiner does not state how a perforated non-transparent divider would bathe those portions of the mailpieces not under the perforations). For example, referring to FIG. 4A, the shown divider is solid. Material that is at least partially transparent to UV is known to those of skill in the art and need not be described in detail. Thus, it is clear from the description above that one of skill in the art would know that the inventor was disclosing the material of the divider bottom being at least partially transparent to UV radiation. A perforated divider that is also made of transparent material would still allow the UV source to bathe the mailpieces and the description of a solid at least partially transparent divide bottom would enable such a system as well.

Accordingly, Appellant respectfully submit that claims 38, 39 and 42 are patentable and that the final rejection is in error and should be reversed.

B Claims 26 and 34 are not Unpatentable under 35 U.S.C. § 103(a)

Claims 26 and 34 are in the case and under final rejection of the Examiner and stand rejected under 35 U.S.C. § 103(a) as allegedly being rendered obvious by U.S.

Serial No.: 09/683,417
Attorney Docket No.: F-428

Patent

Patent Application Publication No. 2004/0020978 by Webb ("Webb '978") in view of U.S. Patent No. 4,673,914 to Lee ("Lee '914").

Appellants respectfully disagree with the rejection and urge its reversal for at least the reasons stated below.

In rejecting a claim under 35 U.S.C. §103, the Examiner is charged with the initial burden for providing a factual basis to support the obviousness conclusion. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967); *In re Lunsford*, 375 F.2d 385, 148 USPQ 721 (CCPA 1966); *In re Freed*, 425 F.2d 785, 165 USPQ 570 (CCPA 1970). The Examiner is also required to explain how and why one having ordinary skill in the art would have been led to modify an applied reference and/or combine applied references to arrive at the claimed invention. *In re Ochiai*, 37 USPQ2d 1127 (Fed. Cir. 1995); *In re Deuel*, 51 F.3d 1552, 34 USPQ 1210 (Fed. Cir. 1995); *In re Fritch*, 972 F.2d 1260, 23 USPQ 1780 (Fed. Cir. 1992); *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). See *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. ___, 127 S.Ct. 1727, 1735 (2007).

Initially, Lee is not properly combined with Webb. The cited references are non-analogous art since Lee is directed toward automobile door and ignition switching and alarm systems. Webb teaches only a door activated switch as a safety switch, but nowhere contemplates access control.

Also, contrary to the Examiner's assertion, push buttons are not taught as interchangeable replacements with physical keys in Lee. In Lee, the push button may be used because access control has been achieved with a code. Therefore, in direct contradiction to the Examiner's assertion, Lee teaches that the push button can replace the physical key only when a security code is obtained by another system to replace the access control functions of the physical key.

Accordingly, one of skill in the art would not look to Lee to modify Webb. One of skill in the art would know that a push button could not provide access control as a physical key can.

Independent claim 26 recites:

26. A mailbox for decontaminating mail comprising:
a door for allowing access to the interior of the mailbox;

Serial No.: 09/683,417
Attorney Docket No.: F-428

Patent

a decontamination system operatively connected to a controller for decontaminating mail;
at least one divider for separating mail; and
a keyed start switch that is engaged and switched to start when a physical key is inserted and turned and that is used to send a decontamination start signal to the decontamination system and to restrict decontamination start signal generation to the mail carrier possessing the physical key. (emphasis added).

Appellant respectfully submits that the cited references do not teach or fairly suggest at least:

"a keyed start switch that is engaged and switched to start when a physical key is inserted and turned and that is used to send a decontamination start signal to the decontamination system and to restrict decontamination start signal generation to the mail carrier possessing the physical key."

Appellant respectfully submits that independent claim 34 includes several similar limitations as those in claim 26 and is patentable over the cited references for at least the reasons described above.

Accordingly, Appellant respectfully submits that the Examiner has failed to establish a prima facie case for an obviousness rejection. Appellants respectfully submit that claims 26 and 34 are patentable over the available cited references and that the final rejection is in error and should be reversed.

C Claims 27, 37 and 40-41 are not Unpatentable under 35 U.S.C. § 103(a)

Claims 27, 37 and 40-41 are in the case and under final rejection of the Examiner and stand rejected under 35 U.S.C. § 103(a) as allegedly being rendered obvious by U.S. Patent Application Publication No. 2004/0020978 by Webb ("Webb '978") in view of U.S. Patent No. 4,673,914 to Lee ("Lee '914") and further in view of U.S. Patent No. 6,997,374 to Stradley, et al. ("Stradley '374").

Appellant respectfully disagrees with the rejection and urges its reversal.

Initially, Lee is not properly combined with Webb as described above. Appellant also respectfully submits that the claims are patentable over the cited references for at

Serial No.: 09/683,417
Attorney Docket No.: F-428

Patent

least the reasons described with reference to the associated dependent claim and any intervening claims.

Furthermore, with regard to dependent claims 40-41, the cited references do not teach or suggest several limitations of the claims.

For example, dependent claim 40 recites:

40. The decontaminating device of claim 34 further comprising:
a communications device for providing status information to a remote user located inside a home and wherein the communications device is configured to provide an indication to the remote user indicating that the mail has arrived and then provide an indication to the remote user indicating that a sanitization process is underway. (emphasis added).

Appellant respectfully submits that the cited references do not teach or fairly suggest the above noted limitations.

Accordingly, Appellant respectfully submits that the Examiner has failed to establish a prima facie case for an obviousness rejection. Appellants respectfully submit that claims 27, 37 and 40-41 are patentable over the available cited references and that the final rejection is in error and should be reversed.

D Claim 35 is not Unpatentable under 35 U.S.C. § 103(a)

Claim 35 is in the case and under final rejection of the Examiner and stands rejected under 35 U.S.C. § 103(a) as allegedly being rendered obvious by U.S. Patent Application Publication No. 2004/0020978 by Webb ("Webb '978") in view of U.S. Patent No. 4,673,914 to Lee ("Lee '914") and further in view of U.S. Patent No. 6,646,270 to Cunningham ("Cunningham '270").

Appellant respectfully disagrees with the rejection and urges its reversal.

Initially, Lee is not properly combined with Webb as described above. Appellant also respectfully submits that the claims are patentable over the cited references for at least the reasons described with reference to the associated dependent claim and any intervening claims.

Furthermore, with regard to dependent claim 35, the cited references do not teach or suggest all of the limitations of the claim.

Serial No.: 09/683,417
Attorney Docket No.: F-428

Patent

For example, dependent claim 35 recites:

35. The mailbox of claim 26 further comprising:
reflective shielding operatively connected to the mailbox to prevent
UV radiation from escaping. (emphasis added).

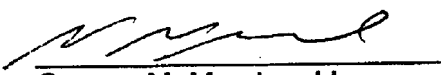
Appellant respectfully submits that Cunningham teaches a reflective coating only on the sidewalls for the purpose of further enhance the action of the light on the mailpieces, but does not teach or suggest coating the entire mailbox as a shield.

Accordingly, Appellant respectfully submits that the Examiner has failed to establish a prima facie case for an obviousness rejection. Appellants respectfully submit that claim 35 is patentable over the available cited references and that the final rejection is in error and should be reversed.

IX. Conclusion

In Conclusion, Appellant respectfully submits that the final rejection of claims 26-27, 34-35 and 37-42 is in error for at least the reasons given above and should, therefore, be reversed.

Respectfully submitted,



George M. Macdonald
Reg. No. 39,284
Attorney for Appellants
Telephone (203) 924-3180

PITNEY BOWES INC.
Intellectual Property and Technology Law Department
35 Waterview Drive, P.O. Box 3000
Shelton, CT 06484-8000

Serial No.: 09/683,417
Attorney Docket No.: F-428

Patent

VIII – CLAIMS APPENDIX
APPENDIX A

26. A mailbox for decontaminating mail comprising:
a door for allowing access to the interior of the mailbox;
a decontamination system operatively connected to a controller for decontaminating mail;
at least one divider for separating mail; and
a keyed start switch that is engaged and switched to start when a physical key is inserted and turned and that is used to send a decontamination start signal to the decontamination system and to restrict decontamination start signal generation to the mail carrier possessing the physical key.

27. The mailbox of claim 26, wherein
the controller includes a communications device for providing status information to a remote user located inside a home.

34. A decontaminating device including a decontamination chamber comprising:
a door for allowing access to the interior of the decontamination chamber;
a decontamination system operatively connected to a controller for decontaminating mail;
at least one divider for separating mail; and
a keyed start switch that is engaged and switched to start when a physical key is inserted and turned and that is used to send a decontamination start signal to the decontamination system and to restrict decontamination start signal generation to the mail carrier possessing the physical key.

35. The mailbox of claim 26 further comprising:
reflective shielding operatively connected to the mailbox to prevent UV radiation from escaping.

Serial No.: 09/683,417
Attorney Docket No.: F-428

Patent

37. The mailbox of claim 27 wherein:
the communications device includes a wireless network communications
channel.

38. The mailbox of claim 26 wherein:
the divider material is at least partially transparent to UV radiation.

39. The mailbox of claim 34 wherein:
the decontamination system includes a UV source; and
the divider material is at least partially transparent to UV radiation.

40. The decontaminating device of claim 34 further comprising:
a communications device for providing status information to a remote user
located inside a home and wherein the communications device is configured to provide
an indication to the remote user indicating that the mail has arrived and then provide an
indication to the remote user indicating that a sanitization process is underway.

41. The mailbox of claim 37 wherein:
the communications device is configured to provide an indication to the remote
user indicating that the mail has arrived and then provide an indication to the remote
user indicating that a sanitization process is underway.

42. A mailbox for decontaminating mail comprising:
a door for allowing access to the interior of the mailbox;
a decontamination system including a UV source operatively connected to a
controller for decontaminating mail;
reflective shielding operatively connected to the mailbox to prevent UV radiation
from escaping;
at least one divider for separating mail including divider material that is at least
partially transparent to UV radiation; and

Serial No.: 09/683,417
Attorney Docket No.: F-428

Patent

a start switch that is engaged and that is used to send a decontamination start signal to the decontamination system.

Serial No.: 09/683,417
Attorney Docket No.: F-428

Patent

Appendix IX – Evidence Appendix

None

Serial No.: 09/683,417
Attorney Docket No.: F-428

Patent

Appendix X – Related Proceedings Appendix

None